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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,417	10/10/2001	Paul Swift	34580.001CC	9594

21907 7590 08/05/2003

ROZSA & CHEN  
15910 VENTURA BOULEVARD  
SUITE 1601  
ENCINO, CA 91436

EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 08/05/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/975,417

Applicant(s)

SWIFT

Examiner

Luong

Art Unit

3682



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 5/28/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Vinh T. Luong  
Primary Examiner

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachments A-D

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1. The Amendment and the substitute specification filed on May 28, 2003 (Paper Nos. 4 and 5) have been entered. Note that applicant wrongly identifies the serial number of the instant application as "09/957,417" in Paper Nos. 4 and 5. It should have been changed to "09/975,417."
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Gapinski *et al.* (US Patent No. 6,035,743 filed on March 18, 1998 and cited in applicant's parent application Serial No. 09/360,561).

At the outset, note that this application is a Continuation-in-Part (CIP) of application Serial No. 09/360,561 (SN'561) filed on May 26, 1999 which is a CIP of application Serial No. 08/923,022 (SN'022) filed on September 3, 1997. Only the common part of this application and SN'022 are entitled to the filing date of September 3, 1997. See MPEP 201.08. Applicant now claims, *e.g.*, "a first top rear spring-loaded retaining plate" in claim 5 which was not shown and adequately disclosed in SN'022. Therefore, the claims in this application are not entitled to the filing date of SN'022. In other words, since: (a) the claims in this application are drawn to new Figs. 18-22 of this application as described on page 30 et seq. of the original specification; and (b) these new Figs. 18-22 had not been disclosed in SN'022 and SN'561, therefore, claims 5-8 are entitled to the filing date of October 10, 2001 of this application only. The US Patent No. 6,035,743 was filed on March 18, 1998, *i.e.*, before the filing date of October 10, 2001 of this application and before the filing date of May 26,

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1999 of the parent application SN' 561. Thus, Pat. '743 is qualified as prior art under 35 USC 102(e) to reject claims 5-8 in this application.

Regarding claim 5, Gapinski teaches a flip-flop bicycle pedal, comprising:

- a. a main body 24 (Fig. 1) pivotable about a transverse axis and having a spindle bolt 32 for connecting to a bicycle, a top side 28 and a bottom side 31 (*id.*, line 7 *et seq.*, column 3);
- b. said top side 28 having a first top toe cleat clamp 26 (Fig. 1) which conforms to a bottom of a road type bicycle shoe cleat 22, the first top toe cleat clamp 26 having a front recess 100, 106 (Figs. 3 and 4) for receiving a front tongue 84 (Fig. 4, Attachment A) of the road type bicycle shoe cleat 22, said top side 28 also having a first top rear spring-loaded retaining plate 42 (see spring 112 in Figs. 5 and 8) pivotable on said main body 24, the first top rear spring-loaded retaining plate 42 having a recess 114 for receiving a rear tongue 86 (Fig. 4) of the road type bicycle shoe cleat 22 and when a force is applied to the first top rear spring-loaded retaining plate 42, the first top rear spring-loaded retaining plate 42 moves away from said main body 24 such that the rear tongue 86 engages the recess 114 of the first top rear spring-loaded retaining plate 42, where the first top rear spring-loaded retaining plate 42 springs back into a locking position, and thereby locks the rear tongue 86 of the road type bicycle shoe cleat 22 thereto; and
- c. said bottom side 31 having a second bottom toe cleat clamp 30 which is smaller than said first top toe cleat clamp 26 of said top side 28 and conforms to a bottom of a mountain bicycle type shoe cleat (not shown, see lines 28-33, column 3, and US Patent No. 5,692,415 which is incorporated into the disclosure of Gapinski), the second bottom toe cleat clamp 30 of said

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bottom side 31 having a front locking member 30 located adjacent to said front top rear spring-loaded retaining plate 42 of said top side 28 for receiving a front tongue of the mountain bicycle type shoe cleat (not shown), said bottom side 31 also having a second bottom rear spring-loaded retaining member (Attachment A) pivotable on said main body 24 such that a rear tongue of the mountain bicycle type shoe cleat (not shown) engages inside a recess (Attachment A) of the second bottom rear spring-loaded retaining plate of said bottom side 31, where the second bottom rear spring-loaded plate of said bottom side 31 springs back into a locking position, and thereby locks the rear tongue of the mountain bicycle type shoe cleat thereto.

Regarding claim 6, Gapinski teaches a bicycle pedal, comprising:

- a. a main body 24 (Fig. 1) pivotable about a transverse axis and having a spindle bolt 32 for connecting to a bicycle, a first cleat clamp side 28 and a second cleat clamp side 31;
- b. said first cleat clamp side 28 conforming to a bottom of a road type bicycle shoe cleat 22 and having a recess 100, 106 (Figs. 3 and 4) for receiving a first tongue 84 of the road type bicycle shoe cleat 22, said first cleat clamp side 28 also having a first spring-loaded retaining plate 42 pivotable on said main body 24 for receiving a second tongue 86 of the road type bicycle shoe cleat 22 and when a force is applied to the first spring-loaded retaining plate 42, the first spring-loaded retaining plate 42 moves away from said main body 24 such that the second tongue 86 engages the first spring-loaded retaining plate 42, where the first spring-loaded retaining plate 42 springs back into a locking position, and thereby locks the second tongue 86 of the road type bicycle shoe cleat 22 thereto; and

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c. said second cleat clamp side 31 being smaller than said first cleat clamp side 28 and conforming to a bottom of a mountain bicycle type shoe cleat (not shown, see lines 28-33, column 3, and US Patent No. 5,692,415 which is incorporated into the disclosure of Gapinski), said second cleat clamp side 28 having a locking member 30 located adjacent to said first spring-loaded retaining plate 42 of said first cleat clamp side 28 for receiving a first tongue of the mountain bicycle type shoe cleat (not shown), said second cleat clamp side 31 also having a second spring-loaded retaining member (Attachment A) pivotable on said main body 24 such that a second tongue of the mountain bicycle type shoe cleat (not shown) engages the second spring loaded retaining member (Attachment A) of said second cleat clamp side 31, where the second spring-loaded retaining member (Attachment A) of said second cleat clamp side 31 springs back into a locking position, and thereby locks the second tongue of the mountain bicycle type shoe cleat thereto.

Regarding claim 7, Gapinski teaches a bicycle pedal, comprising:

a. a main body 24 pivotable about a transverse axis and having a spindle bolt 32 for connecting to a bicycle, a first side 28 and a second side 31;

b. said first side 28 conforming to a bottom of a road type bicycle shoe cleat 22 and having means 100, 106 for receiving a first tongue 84 (Attachment A) of the road type bicycle shoe cleat 22, said first side 28 also having a first spring-loaded retaining plate 42 pivotable on the main body 24 for receiving a second tongue 86 of the road type bicycle shoe cleat 22 and when a force is applied to the first spring-loaded retaining plate 42, the first spring-loaded retaining plate 42 moves away from said main body 24 such that the second tongue 86 is retained within the

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spring-loaded retaining plate 42, where the first spring-loaded retaining plate 42 moves back into a locking position, and thereby locks the second tongue 86 of the road type bicycle shoe cleat 22 thereto; and

c. said second side 31 conforming to a bottom of a mountain bicycle type shoe cleat (not shown, see lines 28-33, column 3, and US Patent No. 5,692,415 which is incorporated into the disclosure of Gapinski) and having a locking member (Attachment A) for receiving a first tongue of the mountain bicycle type shoe cleat (not shown), said second side 31 also having a second spring-loaded retaining member (Attachment A) pivotable on said main body 24 such that a second tongue of the mountain bicycle type shoe cleat is retained within the second spring-loaded retaining member (Attachment A) of said second side 31, where the second spring-loaded retaining member (Attachment A) of said second side 31 moves back into a locking position, and thereby locks the second tongue of the mountain bicycle type shoe cleat thereto.

Regarding claim 8, said second side 31 is smaller than said first side 28 (Fig. 4).

4. Applicant's arguments filed May 28, 2003 (Paper No. 5) have been fully considered but they are not persuasive.

### **35 USC 112, SECOND PARAGRAPH**

The rejection under 35 USC 112 has been withdrawn in view of applicant's remarks.

### **35 USC 102(e)**

At the outset, applicant contends, *inter alia*, that Gapinski Patent should not be cited against applicant's instant Application 09/957,417 because Figs. 5a-c of grand parent Application 08/923,022

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were changed to be Figs. 7a-c in this Appl.'417, and these Figs. 7a-c *essentially* disclose the present invention as claimed (page 10 of Paper No. 5).

The examiner respectfully submits that Figs. 5a-5c of grand parent Appl.'417 were also changed to be amended Figs. 8a-c in parent Continuation-in-part Application 09/360,561. Claims 8-14 of parent Appl.'561 drawn to its amended Figs. 8a-c were rejected under 35 USC 112, first paragraph. See the final rejection on May 14, 2001 (Attachment B). These claims 8-14 were rejected because applicant's disclosure of Appl.'561 did not provide an adequate description as to how applicant makes/uses the spring loaded retaining plate 204 and the spring loaded retaining member 216 (Attachment B).

Second, applicant compares Figs. 18 and Figs. 7a-7c of this application and asserts that *"everything that the Applicant is disclosing and claiming in the present '417 Application was in fact disclosed in the original application filed on September 3, 1997."* (Page 11 of Paper 5).

Contrary to applicant's remarks, the comparison of Figs. 18 and Figs. 7a-7c of this application shows that *everything that the Applicant is disclosing and claiming in the present '417 Application was in fact not disclosed in the original application filed on September 3, 1997*. To illustrate this point, the examiner respectfully refers to Attachment C wherein Figs. 7a-7c are shown on the left side and Figs. 18 and 19 are shown on the right side. One may reasonably recognize that the spring plate 204 of the first pedal in Fig. 7b is patentably distinct from the spring plate 204 of the second pedal in Fig. 19 due to the pivoted recess 209 and the springs 580 and 582.



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Third, applicant avers that it is abundantly clear that the spring action is talked about is clearly intended and clearly discussed in the patent text. (Page 12 of Paper 5).

However, as seen in the rejection set forth in Attachment B, since Figs. 7a-7c fail to show the claimed spring as required under 37 CFR 1.83(a), it is not clear as to how applicant makes/uses the spring such that the plate 204 moves back when the cleat is inserted. Similarly, since Figs. 7a-7c fail to show the spring that biases the clamp 208 in Fig. 7b, it is not clear as to how applicant makes/uses the spring such that the clamp 208 “is pushed back under the downward movement of the cleat and finally springs forward to lock the SPD compatible cleat onto the pedal (213)” as described in the fourth paragraph on page 9 of Appl.’022.

Fourth, in the same vein of arguments, applicant asserts that the plate 216 in Fig. 7b is spring loaded (4th paragraph, page 12 of Paper No. 5). The examiner respectfully submits that since Figs. 7a-7c fail to show the claimed spring as required under 37 CFR 1.83(a), it is not clear as to how applicant makes/uses the spring such that the plate 216 moves back when the cleat is inserted.

Applicant emphasizes that “for purposes of clarity in Figure 18, the spring 580 has been shown but it is abundant clear that it is about a bolt 205 which was fully disclosed in the original patent text.” However, if the plate 204 in Fig. 7b is pivoted about the bolt 205 or if the plate 216 is pivoted about the bolt 211, then, the clamp 208 in Fig. 7b is pivoted about which bolt?

In response to applicant’s arguments in paragraph 7, page 13 of Paper No. 5, it is settled that in establishing conception, a party must show possession of *every feature* recited in the count, and that *every limitation* of the count must have been known to the inventor at the time of the alleged

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conception. *Coleman v. Dines*, 754 F.2d 353, 359, 224 USPQ 857, 862 (CAFC 1985); *Sewall v. Walters*, 30 USPQ2d 1356, 1358-59 (CAFC 1994); and *Cabilly v. Boss*, 55 USPQ2d 1238, 1255 (BPAI 1998).

In the instant case, the written description of the grand parent Appl.'022 and the drawings thereof (Figs. 7a-c) did not satisfy the requirement under USC 112, first paragraph. Consequently, applicant did not reasonably convey to one skilled in the relevant art that the applicant at the time the grand parent application was filed, had possession of the claimed invention. Therefore, the embodiment of Fig. 7a-c should not be awarded the earlier filing date.

Assuming *arguendo* that claims 5-8 of this application were read on Figs. 7a-c of Appl.'022, then, these claims 5-8 should be rejected under 35 USC 112, first paragraph, by the same or similar rejection set forth in the parent Appl.'561 (Attachment B).

More important, a review of the prosecution history shows that applicant did not contest the rejection under 35 USC 112, first paragraph, in parent Appl.'561. Indeed, applicant chose to abandon Appl.'561 and filing this CIP Appl.'417. Applicant's "silence implies assent," *a fortiori*, the previous rejection under 35 USC 112, first paragraph, is deemed to be proper. *Cf.*, (Unpublished) *Ex parte Knapton*, 67 USPQ2d 1059 (BPAI 2002).

In summary, Figs. 7a-c of this Appl.417 *essentially* does not disclose the present invention as claimed in claims 5-8 of this application due to the fact that Figs. 7a-c fail to show, among other things, the *essential or critical subject matter*, *i.e.*, the spring(s) that bias(es) the plates as claimed. *In re Mayhew*, 188 USPQ 356 (CCPA 1976) and MPEP706.03(c). Therefore, claims 5-8 of this

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application are deemed to be read on new Figs. 18-22 only. Figs. 18-22 were filed on October 10, 2001. Hence, Patent No. 6,035,743 (Gapinski) filed on March 18, 1998 is qualified as 35 USC 102(e) reference.

Fifth, applicant discusses certain key differences between the present invention as claimed and Gapinski patent (page 13 of Paper 5). Applicant contends that applicant's cleat is affixed to the shoe, then to the pedal, meanwhile, Gapinski's cleat is not fixed to the shoe but it is fixed to a full pedal adapter where the shoe itself is inserted into the pedal adapter (page 14, Paper 5).

Applicant apparently overlooks the fact that applicant's claims 5-8 call for the pedal, not the process of using the pedal. The argument about the intended use of applicant's pedal is not accorded patentable weight. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, note that the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

In the case at hand, applicant's recitation of the intended use of applicant's claimed invention does not result in a structural difference between the claimed invention and the prior art Gapinski. To illustrate this point, the examiner prepares Attachment D wherein applicant's claimed pedal in Fig.

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19 is shown side by side with Gapinski's pedal. One may reasonably infer from Attachment D that Gapinski's pedal is substantially identical to applicant's pedal.

Sixth, applicant strenuously states that Fig. 5 of Gapinski shows that the method by which the cleat of Gapinski is attached and disattached is totally different from the applicant's method (page 14, Paper 5). Nevertheless, applicant's claims are not method claims. The examiner respectfully submits that the Court has long laid applicant's arguments to rest by pointing out that when each element of a patent claim is found in one prior art reference, the patent claim is invalid, and the invention is said to be anticipated as a matter of law. This is true, even if the intended use of the anticipating device is different from the intended use of the claimed device. *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1523 (DC C. Calif. 1986) and cases cited therein. Simply put, applicant's recitation with respect to the manner in which applicant's claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus if the prior art apparatus teaches all the structural limitations of the claims. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1087) and MPEP 2114.

On the other hand, it is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in reference, or are "fully met" by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789

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(CAFC 1983). In addition, applicant apparently overlooks a well-established expectation that similar structures would behave similarly. *In re Merck & Co., Inc.*, 231 USPQ 375 (CAFC 1986).

In the case *sub judice*, Gapinski teaches the pedal comprising the main body, top and bottom sides, top and bottom cleat clamps, and top and bottom spring-loaded retaining plates/members. Therefore, Gapinski's pedal is expected to behave in the same manner as applicant's pedal, i.e., to receive the road and/or mountain bicycle shoe cleat as expressly described in Gapinski's specification. The necessary inherence of Gapinski's pedal is flown naturally from Gapinski's teaching of the same type of applicant's pedal. *In re Best*, 195 USPQ 430, 433 (CCPA 1977) and MPEP 2112.

Seventh, applicant insists that Gapinski's claim 1 recites a locking mechanism including a pin (78) extending from a base member and a recess (48) formed on said main body for receiving said pin (78). Nevertheless, Gapinski's pin 78 and recess 48 are formed on the cleat, not the pedal as seen in Fig. 4 and line 6 et seq., column 7. Applicant's arguments about the pin and the recess are immaterial in so far as applicant does not claim a combination of the pedal and the cleat. Gapinski's pedal contains each and every positive claimed element of applicant's claims, thus, applicant's claims are anticipated by Gapinski as a matter of law. *Kalman v. Kimberly Clark Corp, supra*.

Finally, applicant discusses US Patent No. 5,692,415 issued to Lin. Applicant asserts that Lin's pedal is complicated and needs much installation space. The examiner respectfully points out that Lin is incorporated into Gapinski's disclosure. Lin is the evidence to show how Gapinski makes/uses Gapinski's mountain bike style clipless structure 30 to satisfy the requirement under 35

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USC 112, first paragraph. As such, Gapinski reference complies with all statutory requirement, it is properly qualified as a prior art to reject applicant's claims as explained above.

For the reasons set forth above, the rejection based on Gapinski is maintained.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

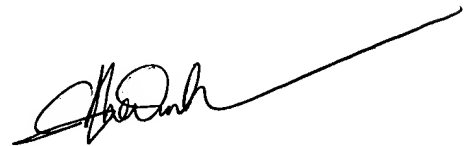
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 8:30 AM EST to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

August 4, 2003



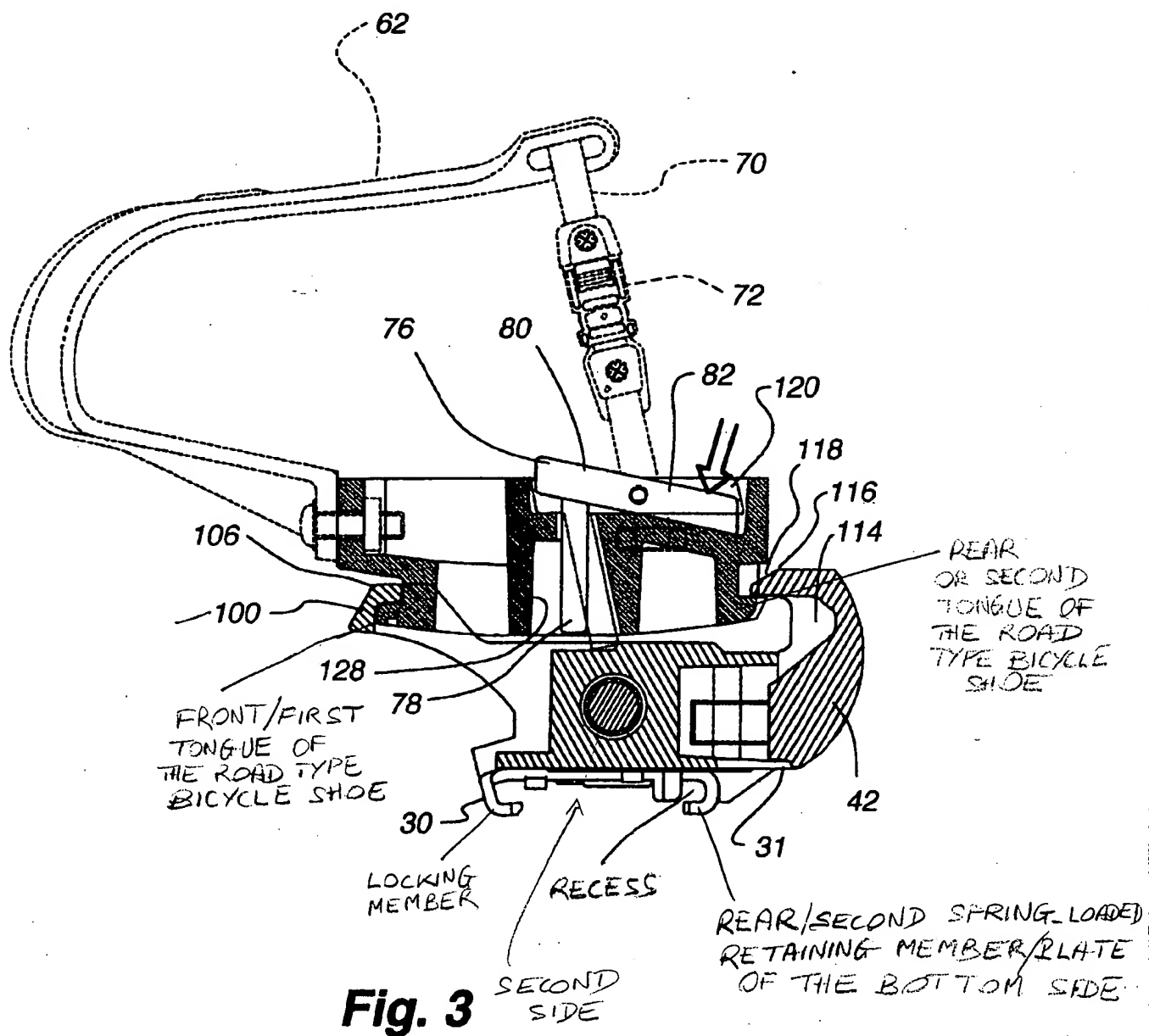
Vinh T. Luong  
Primary Examiner

Application/Control Number: 09/975,417

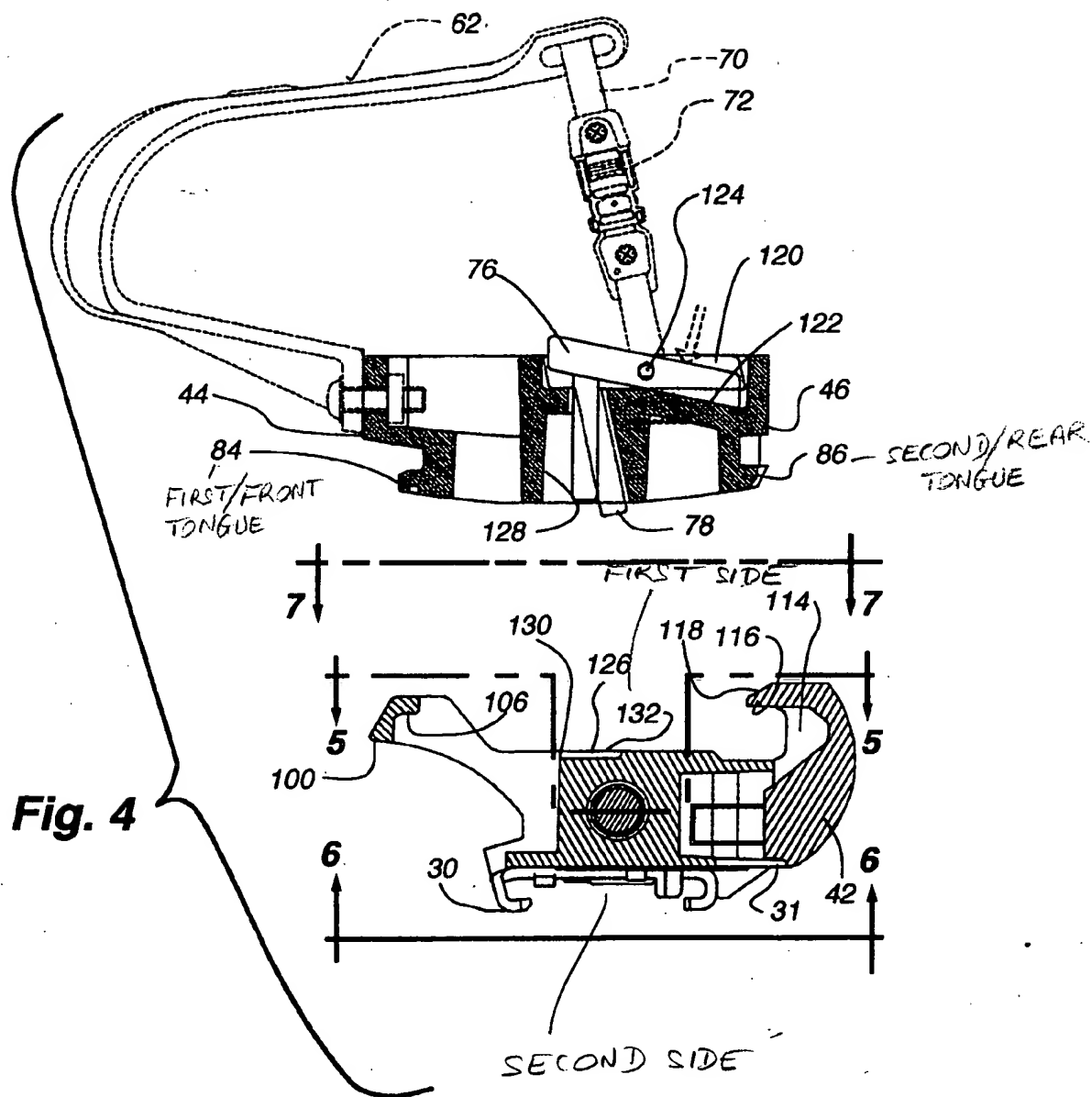
Art Unit: 3682

# **ATTACHMENT**

## **A**







Application/Control Number: 09/975,417

Art Unit: 3682

# **ATTACHMENT**

## **B**



UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/360,561 05/26/99 SWIFT

P 34580.001C

021907  
ROZSA & CHEN  
15910 VENTURA BOULEVARD  
SUITE 1601  
ENCINO CA 91436

PM82/0514

EXAMINER

LUONG, V

ART UNIT

PAPER NUMBER

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DATE MAILED:

05/14/01

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Commissioner of Patents and Trademarks

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- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 3/5/01
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

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- 4) ☒ Claim(s) 8-14 is/are pending in the application.
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- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/26/99 is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 3/5/01 is: a) ☐ approved b) ☒ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Vinh T. Luong  
Primary Examiner

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- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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1. The amendment, substitute specification and declaration filed on March 5, 2001 have been entered.
2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on March 5, 2001 have been partially approved.

(a) The drawing correction in Figs. 1-4b and 6a-7b has been approved;

(b) The drawing correction in Figs. 5a-5c and 8a-12 has been disapproved since:

(1) Figs. 5a-5c are apparently duplicate of Figs. 8a-8c. Applicant should have canceled either Figs. 5a-5c or Figs. 8a-8c; and

(2) Figs. 8a-12 are inconsistent with the specification, e.g., page 10 of the substitute specification describes that Figs. 9a and 9b show a prior art device, however, Figs. 9a and 9b do not have a label "PRIOR ART."

3. The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Correction is required.

Note that Figs. 8a-8c and 10a-12 apparently show different combinations of prior art pedals available commercially such as LOOK/SPD, SPEEDPLAY and INSTEP LOOK pedals or adapters. See, e.g., page 10 of the specification. Applicant should have shown each of the old structures "LOOK," "SPD," "SPEEDPLAY" and "INSTEP LOOK," etc. separately and disconnected from applicant's invention (i.e., the improvement). Since applicant combined the old and new structures

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in Figs. 8a-8c and 10a-12, it is unclear which structures are old and which structures are new/improved structures.

4. The drawings are objected to because: (a) Figs. 8a-8c and 10a-12 should have had the labels PRIOR ART, LOOK, SPD and SPEEDPLAY, etc. in order to distinguish among the old structures; and (b) each part of the invention such as the transverse axis in claim 8 should be designated by a referential numeral or character. Correction is required.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features such as: (a) the spring of the rear spring-loaded retaining plate and the spring of the rear spring-loaded retaining member in claims 8, 10 and 12; (b) the tongue of the road type bicycle shoe cleat and the front tongue of the mountain bicycle type shoe cleat in claim 8; (c) the first tongue of the road type bicycle shoe cleat and the first and second tongues of the mountain bicycle type shoe cleat in claims 10 and 12; and (d) the moved away position and the locking position of the spring-loaded retaining road in claims 8, 10 and 12 must be shown or the features canceled from the claims. No new matter should be entered.

Note that applicant's Figs. 5a-5c and 8a-8c show a pedal which is not attached to any shoe cleat, meanwhile, Fig. 10c shows a pedal attached to the LOOK shoe cleat only. The other figures show the shoe cleat or adapter *per se*. None of the figures shows the combination of the bicycle pedal and the rear and front tongues or the first and second tongues of the road and/or mountain bicycle type shoe cleats as claimed. In addition, the claims call for the spring-loaded retaining plate or member. However, Figs. 8a-8c do not show any spring of the plate 204 and member 216. See, e.g., page 23 of the substitute specification. In addition, a moved position such as the moved away

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position and the locking position of the spring-loaded retaining road should have been shown in accordance with 37 C.F.R. 1.84(h)(4).

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter such as "a transverse axis" in claim 8. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

7. The disclosure is objected to because of the following informalities: (a) each part of the invention such as the transverse axis in claim 8 should be designated by a referential numeral or character; and (b) the descriptions in the specification are inconsistent with each other, e.g., Figs. 5a-5c are apparently duplicate of Figs. 8a-8c, however, applicant describes Figs. 5a-5c and 8a-8c differently as seen, e.g., on pages 10, 17, 22 and 23 of the specification. Appropriate correction is required.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 8-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

#### **INADEQUATE DESCRIPTION**

Claim 8 claims a flip-flop pedal comprising:

a. a main body pivotable about a transverse axis and having a top side and a bottom side;

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b. said top side having a toe cleat clamp *which conforms to a bottom of a road type bicycle shoe cleat*, the toe cleat clamp having a front recess *for receiving a front tongue of the road type bicycle shoe cleat* and a rear **spring-loaded** retaining plate **pivotal on said main body**, the rear spring-loaded retaining plate having a recess *for receiving a rear tongue of the road type bicycle shoe cleat* and *when a force is applied to the spring-loaded retaining plate, the spring-loaded retaining plate moves away from said main body such that the rear tongue engages the recess of the spring-loaded retaining plate, where the spring-loaded retaining plate springs back into a locking position, and thereby locks the rear tongue of the road type bicycle shoe cleat thereto*; and

c. said bottom side having a toe cleat clamp which is smaller than said toe cleat clamp of said top side and *conforms to a bottom of a mountain bicycle type shoe cleat*, the toe cleat clamp of said bottom side having a front locking member located adjacent to said rear spring-loaded retaining plate of said top side *for receiving a front tongue of the mountain bicycle type shoe cleat* and a rear **spring loaded** retaining member **pivotal on said main body** such that a rear tongue of the mountain bicycle type shoe cleat engages inside a recess of the rear spring loaded retaining plate of said bottom side, where the rear spring-loaded plate of said bottom side springs back into *a locking position, and thereby locks the rear tongue of the mountain bicycle type shoe cleat thereto*.

First, Figs. 8a-8c merely show the pedal without the road and mountain bicycle type shoe cleats. It is unclear as to, e.g., (a) what is/are the difference(s) between the front tongues of the *road* and *mountain* bicycle shoe cleats; and (b) how applicant's flip-flop pedal is used with the tongues of the *road* and *mountain* bicycle shoe cleats as claimed. Similarly, claims 10 and 12 claim the first tongues of the road and mountain shoe cleats. However, Figs. 8a-8c merely show the pedal without



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the road and mountain bicycle type shoe cleats. It is unclear as to, e.g., (a) what is/are the difference(s) among the first tongues of the *road* and *mountain* bicycle shoe cleats; and (b) how applicant's flip-flop pedal is used with the tongues of the *road* and *mountain* bicycle shoe cleats as claimed.

Second, the claims call for the *spring-loaded* retaining plate or member. However, Figs. 8a-8c do not show any spring of the plate 204 and member 216. See, e.g., page 22 et seq. of the specification. It is unclear as to how applicant loads the unillustrated springs into the plate 204 and member 216 in order to lock the tongues of the shoe cleat to the plate 204 and member 216 in the locking position as claimed.

Third, the claims call for the rear **spring loaded** retaining member (216) **pivotal on the main body** (199). However, Figs. 8a-8c show that the member 216 is fixedly attached to the body 199 by two screws 214. Thus, the member 216 is not pivotable on the body 199 as now claimed. It is unclear as to how applicant makes/uses the rear **spring loaded** retaining member (216) such that the member 216 is **pivotal on the main body** (199) as now claimed.

#### NEW MATTER

The claims call for the rear **spring loaded** retaining member (216) **pivotal on the main body** (199). However, Figs. 8a-8c show that the member 216 is fixedly attached to the body 199 by two screws 214, thus, the member 216 is not pivotable on the body 199 as now claimed. The concept that the rear **spring loaded** retaining member (216) such that the member 216 is **pivotal on the main body** (199) is not present in the original disclosure, thus, it is new matter. *In re Anderson*, 176 U.S.P.Q. 331 (CCPA 1973).

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10. Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether:

(a) applicant claims a flip-flop bicycle pedal *per se*, or a combination of a flip-flop bicycle pedal, a road type bicycle shoe cleat and a mountain type bicycle shoe cleat;

(b) the term that appears at least twice such as “a toe cleat clamp” in claim 8 refer to the same or different things. Applicant is respectfully urged to identify each claimed element with reference to the drawings; and

(c) a confusing variety of terms such as: (1) “a *road* type bicycle shoe cleat” and “a *mountain* bicycle type shoe cleat” in claims 8 and 9; (2) “a bicycle road shoe cleat” and “a *mountain* bicycle type shoe cleat” in claims 10 and 11; and (3) “a *mountain* bicycle shoe cleat” in claims 12-14 refer to the same or different things. See M.P.E.P. 608.01(o). Applicant is respectfully urged to identify each claimed element with reference to the drawings

The term such as “*pivotable*” in claims 8, 10 and 12 is vague and indefinite in the sense that things which may be done are not required to be done. For example, the rear spring-loaded retaining member is *pivotable*, but is not structurally required to be pivoted on the main body. See “*crimpable*” and “*discardable*” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986); “*removable*” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992) and “*comparable*” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (Bd. Pat. App. & Inter. 1992).

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The terms such as: (a) “a *road* type bicycle shoe cleat” and “a *mountain* bicycle type shoe cleat” in claims 8 and 9; (b) “a bicycle road shoe cleat” and “a *mountain* bicycle type shoe cleat” in claims 10 and 11; and (c) “a *mountain* bicycle shoe cleat” in claims 12-14 are vague and indefinite since there is no objective standard to define which type of shoe is a road type or a mountain type. Common sense teaches that the road type shoe inherently can be used to ride the mountain bike, i.e., to become a mountain type shoe, or *vice versa*. Moreover, any kind of shoe inherently can be worn by a bicyclist to ride either a mountain bike or a road bike or to walk on a street. In other words, a normal shoe can also be a road bike shoe or mountain bike shoe. It would not be possible to determine whether a particular pedal is covered by applicant’s claims since with regard to the *road* type bicycle shoe cleat, *mountain type* bicycle shoe cleat, etc., whether or not the particular pedal falls within language of the claims would depend upon subjective determinations such as the location of the bicycle, the bicyclist’s intended use of the shoe cleat, or the habit of riding the bicycle of a particular rider on the road or the mountain. See *Ex parte Brummer*, 12 U.S.P.Q.2d 1653, 1655 (BPAI 1989).

The terms such as “a rear **spring-loaded** retaining plate” and “a rear **spring loaded** retaining member” in claims 8, 10 and 12 are inaccurate and misdescriptive since the drawings (Figs. 8a-8c) do not show the springs which are loaded into the plate 204 and the member 216.

11. Claims 8, 10, 12 and 14, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art LOOK and SPD.

Pages 4-6 and 22 et seq. of applicant’s substitute specification describe, e.g., that applicant’s Fig. 8 shows a flip-flop pedal comprising a first prior art LOOK style toe cleat clamp at a top side,

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and a second prior art SPD style toe cleat clamp at a bottom side. The LOOK toe cleat clamp has a front recess and a rear spring-loaded retaining plate for a road type bicycle shoe cleat. The SPD toe cleat clamp has a front locking member and a rear spring-loaded retaining member for a mountain type bicycle shoe cleat.

It is common knowledge in the art to combine the LOOK and SPD toe cleat clamps in order to use with either LOOK toe road type bicycle shoe cleat or SPD mountain type bicycle shoe cleat as desired by the bicyclist. The use of two different toe cleat clamps at the top and bottom to provide the bicyclist of the choice of two different types of shoe cleats is notoriously well known (e.g., see US Patent 5,211,076 issued to Baume et al.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the LOOK and SPD toe cleat clamps in order to use with either LOOK shoe cleat or SPD shoe cleat as desired by the bicyclist as suggested by common knowledge in the art.

12. Claims 9, 11 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

14. Applicant's arguments filed March 5, 2001 have been fully considered but they are not persuasive.

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Applicant contended that Baume does not disclose the spring-loaded locking means for locking different shoe cleats. The examiner fully agrees with applicant. Thus, the rejection based on Baume has been withdrawn. However, the examiner respectfully submits that applicant's Figs. 8a-8c do not show the springs, and the specification does not describe adequately as to how the springs are loaded with the locking means to lock them in the locking position. Therefore, it is unclear as to how applicant makes/uses the claimed *spring-loaded* locking means. The amendment necessitated new rejections above.

15. Applicant's arguments with respect to claims 8-14 have been considered but are moot in view of the new ground(s) of rejection.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-7687. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the

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response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-7687) on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_  
(Signature)


If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 8:30 AM EST to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

May 14, 2001

  
Vinh T. Luong  
Primary Examiner

Application/Control Number: 09/975,417

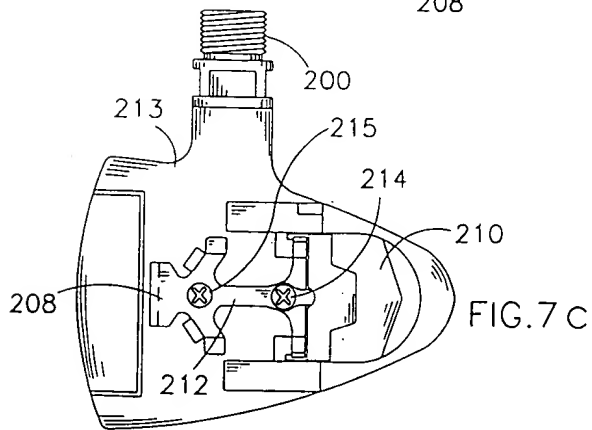
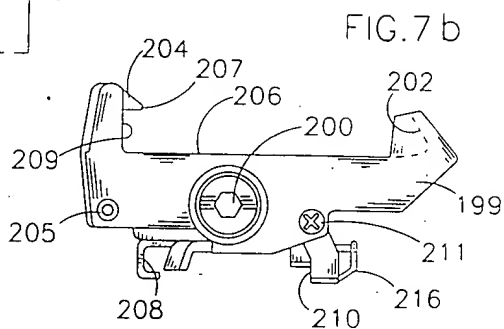
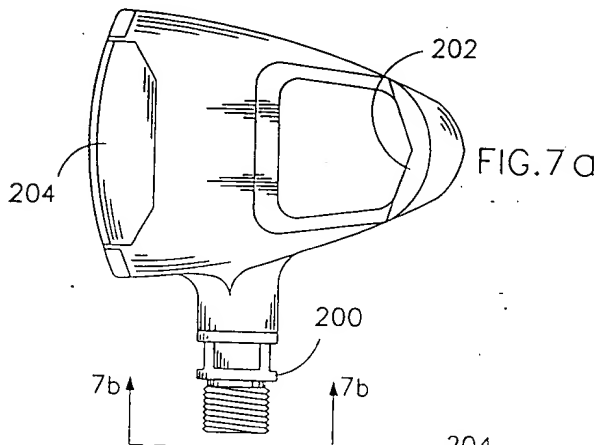
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**ATTACHMENT**

**C**

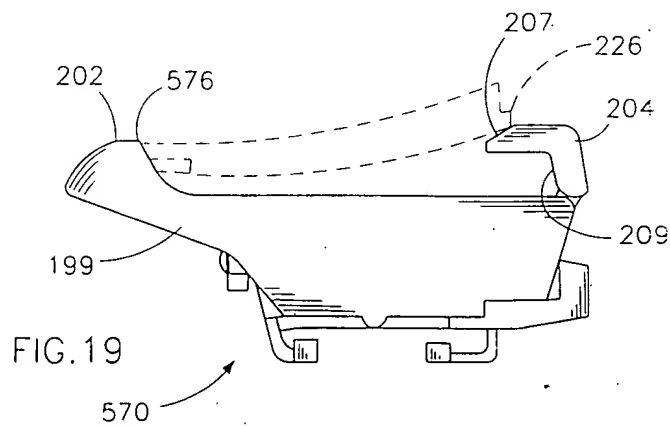
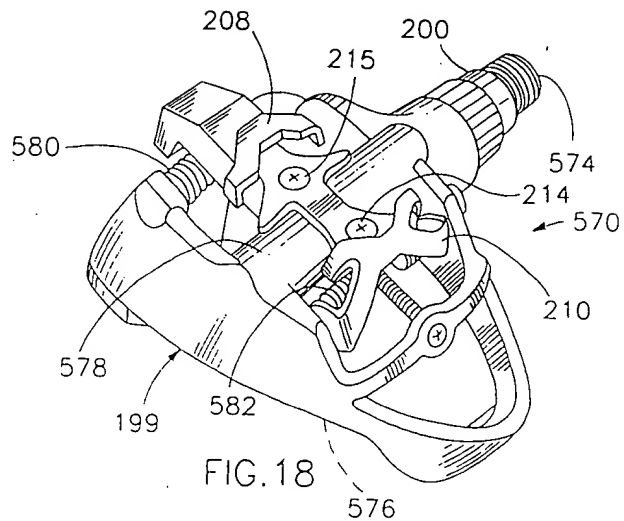
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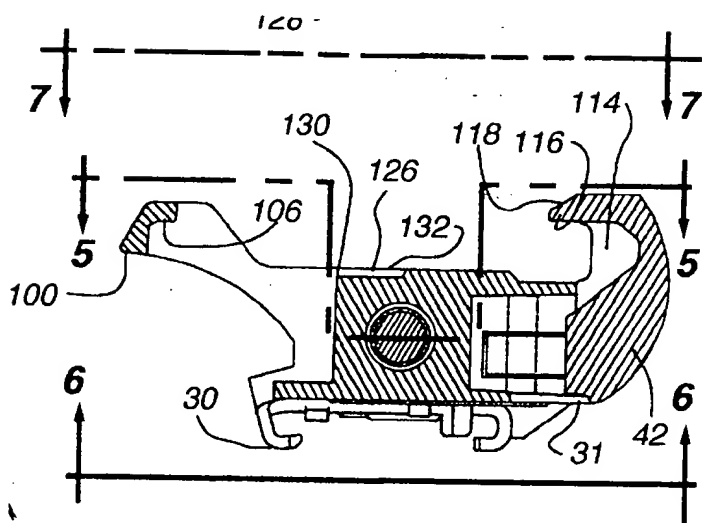
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# **ATTACHMENT**

## **D**

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